

### **REMARKS/ARGUMENTS**

This response is submitted in response to the Office Action mailed June 9, 2009. Reconsideration and allowance are requested.

Claims 1, 4-18, 21-35, and 38-52 are pending in the present application. Claims 2, 3, 19, 20, 36, and 37 were previously canceled. Reconsideration and allowance are requested.

#### ***Summary of Interview with Examiner***

Counsel for Assignee would like to thank Examiner Taylor for the courtesies extended during the telephonic interview conducted on September 3, 2009. During the interview, Counsel for Assignee and the Examiner discussed the prior art of record and the claim language of the present application. Counsel for Assignee and the Examiner discussed possible amendments to the claims. No agreement was reached regarding possible amendments. The interview ended with Counsel for Assignee stating that he would prepare and submit a response to the Office Action incorporating the discussion with the Examiner, as appropriate.

#### ***Claim Rejection under 35 USC 103***

In the Office Action, claims 1, 4-11, 15-18, 21-28, 32-35, 38-45, and 49-52 were rejected under 35 USC § 103 as being unpatentable over Hind et al (US Pub. 2004/0205555, hereinafter "Hind") and Conway (US Pub. 2003/0236777, hereinafter "Conway"). Claims 12-14, 29-31, and 46-48 were rejected under 35 USC § 103 as being unpatentable over Hind and Conway and further in view of Chiu et al. (US Patent 6,452,615, hereinafter "Chiu").

The Applicant respectfully traverses. According to M.P.E.P. § 2141 (II), obviousness under 35 U.S.C. § 103 is determined by performing the factual inquiries provided in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966) and recently affirmed by the U.S. Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). The four factual inquiries enunciated in *Graham* for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;

- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

The Applicant submits that the Office has erred substantively as to the factual findings. Applying these four factual inquiries to the pending claims, in light of what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge, leads to a conclusion that the pending claims are not obvious. According to M.P.E.P. § 2141.02 (VI), when ascertaining the differences between the prior art and the claims in issue, the prior art must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Further, according to M.P.E.P. § 2143.03, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claims 1, 18, 35, and 52

The Applicant submits that if the references are considered in their entirety, the differences between the references and independent claims 1, 18, 35, and 52 are sufficiently large so as to render independent claims 1, 18, 35, and 52 patentable over the references. Specifically, if one considers all of the words in judging the patentability of independent claims 1, 18, 35, and 52, as required by M.P.E.P. § 2141.02 (VI), then one would conclude that **it would not have been obvious, at the time of the invention, to modify the reference to store the first request in the notes document** upon determining that the note-taking device cannot communicate with the server, as recited in independent claims 1, 18, 35, and 52.

In rejecting claims 1, 18, 35, and 52, the Office Action first acknowledged that Hind does not teach storing the first request in the notes document upon determining that the note-taking device cannot communicate with the server. Specifically, the Office Action stated:

Hind is silent as to determining if the note-taking device can communicate with a server; storing the first request in the notes

document upon determining that the note-taking device cannot communicate with the server; determining, subsequent to storing, that the device cannot communicate with the server, and communicating the first request from the note-taking device to the server upon determining that the note-taking device can communicate with the server, as Hind is instead directed to more general accessibility of information.

The Office Action then used Conway to make up the deficiencies in Hind by arguing that:

Conway teaches a network-based information retrieval system that services information requests from a server over a network (Conway, paragraphs 0022 and 0023 and fig. 1). Conway further teaches determining if a target server of a device request is available for communication, storing the request upon determining that the device cannot communicate with the server, subsequent to storing determining if the device can communicate with the server, and communicating the request upon determining that the device can communicate with the server (Conway, see paragraphs 0040-0042, 0045, 0047, 0049 and figs. 5 and 6 where asynchronous transactions are discussed).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Hind and Conway to provide the request management of Conway in the system of Hind, because doing so would "greatly increase the probability of successful internet transactions" (Conway, Abstract). Further, all of the claimed elements (i.e. note-taking device request creation, communication requests to a server, management of failed or unavailable server transaction requests, etc.) were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods to yield predictable results (e.g., effective request processing when server communication is initially unavailable.).

The Applicant respectfully disagrees. Conway does not teach "storing the first request in the notes document," as recited in independent claims 1, 18, 35 and 52. **Instead Conway teaches that transaction/requests are queued until the host becomes available.** See paragraph [0045] of Conway, which recites:

[0045] If the host is unavailable, the transaction/request is prepared for asynchronous communication. **The transaction/request is queued until the host becomes available.** When the host is available the queued transaction/request is transmitted to the host. The Transaction Manager monitors whether the transaction/request has been successfully executed by the host. If the transaction/request is not executed the transaction/request is prepared again and resubmitted to the host until successfully executed. Once the transaction/request is executed by the host an alert center is notified, which provides feedback to the initiating agent that its transaction/request has been successfully executed. If the transaction/request is a part of a batch all of the batch of transactions/request are executed and the alert center is informed that the entire batch has been executed and the initiating agent is informed of this result via the alert center. (Emphasis added.)

The Applicant submits that queuing the transaction/requests is not the same as "storing the first request in the notes document...", as recited in independent claims 1, 18, 35 and 52. When Conway queues the transactions/requests he essentially stores them as a sequence of records. When the host is available, Conway retrieves the transactions/requests from the queue one at a time (probably in sequence) and sends the transactions/requests to the host. The Applicant submits that a notes document is different than a queue because the notes document is a specific document used by a notes-taking device to store the notes that the note taking device has taken, as recited in the preamble of independent claims 1, 18, 35 and 52. Therefore, Conway's queuing of transactions/requests cannot be interpreted to be the same as a storing requests in the notes document because storing request in a notes document is not the same as queuing the requests.

Nevertheless, in an effort to expedite prosecution, the claims have been amended to be further distinguishable over the cited references. Independent claim 1 has been amended to recite "generating a first request at the note-taking device during a first presentation, wherein the first request identifies a portion of a first information captured during the first presentation to insert in a first location in the notes document, the first information comprising information captured by one or more capture devices while the first presentation is proceeding." Support for this amendment can be found throughout the originally filed specification including the figures

and claims as well as paragraphs [0027] – [0033]. Independent claim 1 has also been amended to recite that "the note-taking device is a computing device that enables a user to enter notes."

Support for this amendment can also be found throughout the originally filed specification including FIG. 1 and paragraph [0032]. Independent claims 18, 35, and 52 have been similarly amended. The Applicant respectfully requests that in light of these amendments and remarks the Examiner reconsider the rejection of independent claims 1, 18, 35 and 52.

Claims 4-11, 15-17, 21-28, 32-34, 38-45, and 49-51

The Office Action rejected claims 4-11, 15-17, 21-28, 32-34, 38-45, and 49-51 for essentially the same reasons as used in the previous Final Office Action dated November 13, 2008. The Applicant respectfully disagrees for the same reasons asserted in the corresponding response to Final Office Action dated January 12, 2009 and in the amendment submitted with RCE on April 8, 2009, which are hereby incorporated by reference.

Further, since claims 4-11, 15-17, 21-28, 32-34, 38-45, and 49-51 depend from independent claims 1, 18, 35 and 52 and independent claims 1, 18, 35 and 52 are patentably distinct from Hind and Conway for the reasons discussed above, claims 4-11, 15-17, 21-28, 32-34, 38-45, and 49-51 are also patentably distinct over Hind and Conway for at least the same reasons.

Claims 12-14, 29-31, and 46-48

In rejecting claims 12-14, 29-31, and 46-48, the Office Action acknowledged that the combination of Hind and Conway fail to teach wherein the first information comprises information captured during a first presentation and wherein the portion of the first information is a slide displayed during the first presentation. The Office Action then used Chiu to make up these deficiencies by arguing that "Chiu teaches a method of creating information comprising captures from presentation for insertion in a note document (Chiu, abstract and col. 3, lines 22-57). The information includes slides, audio segments, video segments, and images displayed during the presentation (Chiu, col. 4, lines 47-60; col. 5, lines 8-20; col. 3, lines 22-57; see figs. 3 and 7)." These are the same reasons as used in the previous Final Office Action dated November 13, 2008. The Applicant respectfully disagrees for the same reasons asserted in the

corresponding response to Final Office Action dated January 12, 2009 and in the amendment submitted with RCE on April 8, 2009, which are hereby incorporated by reference.

Further, since claims 12-14, 29-31, and 46-48 depend from independent claims 1, 18, 35 and 52 and independent claims 1, 18, 35 and 52 are patentably distinct from Hind and Conway for the reasons discussed above, claims 12-14, 29-31, and 46-48 are also patentably distinct over Hind and Conway in view of Chiu for at least the same reasons.

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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